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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,572	01/20/2004	Roger McPherson	MCP.01	3468

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EXAMINER
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AMADIZ, RODNEY

ART UNIT	PAPER NUMBER
2629	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/761,572	<b>Applicant(s)</b> MCPHERSON ET AL.	
	<b>Examiner</b> Rodney Amadiz	<b>Art Unit</b> 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

2. Claim 11 is objected to because of the following informalities: Please delete the word "a" in Claim 11. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 12 recites "the processor is further programmed with instructions for configuring the electronic tablet as a printer whereby content is receivable from a coupled computer in a print operation to the electronic tablet and displayed on the display." Support for this limitation is found in the specification on Pg. 1, Paragraph 3 and Pg. 6, Paragraph 32. However, the specification is not clear on how the processor is programmed to configure the

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electronic tablet as a printer. At most the specification states, "a print driver installed on the computer causes the information being printed to be formatted for display on the tablet 100 and then copies the formatted data file to the tablet 100. Is the material "printed" to the tablet a hard copy, such as paper? Does the tablet have a printer whereby it uses paper? As best understood, the Examiner interprets the claim as the electronic tablet being able to receive electronic information from a computer and formatting it to correspond with the display of the tablet. In this case the processor does not need to be configured as a printer. It is not understood what is meant by configuring an electronic tablet as a printer and therefore an explanation is needed to clarify this limitation.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear by what is meant by "configuring the electronic tablet as a printer". The claim is confusing and unclear as to how an electronic tablet is configured to function as a printer. A clear explanation is needed to further explain this configuration.

7. Claim 15 recites the limitation "the data port" on Page 11, lines 4, 11 and 12. There is insufficient antecedent basis for this limitation in the claim. The Examiner will interpret the "data port" as if it refers to the USB port mentioned on Page 11, line 2.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 7, 8, 12, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Noda et al. (U.S. Patent 5,583,742—herein referred to as “Noda”).

As to **Claim 1**, Noda teaches an electronic tablet (***Col. 4, lines 41-43***), comprising: a housing (***Fig. 1, Element 2***); a data port within the housing for receiving viewable content in a digital format (***Fig. 6, Elements 25 and 27 and Col. 5, lines 29-37***); a processor within the housing and coupled to the data port, the processor programmed to execute instructions for converting the digital formatted content into a displayable format (***Col. 4, lines 45-50--It is inherent that any computing device having data ports used to receive information from an external device will undoubtedly have a processor that executes instructions for converting digital into a displayable format that a user may use***); a display coupled to the processor for displaying the content and secured to the housing in a waterproof manner (***Fig. 1, Element 6 and Figs 7 and 9 and Col. 6, lines 8-41***); and an access door in the housing associated with the data port (***Fig. 13a-13c, Element 37 and Fig. 14a-14c, Element 39***) and having a closed position wherein the data port is sealed in a waterproof manner behind the access door (***Fig. 5, Elements 37 and 39 and Col. 7, lines 1-53***).

As to **Claim 7**, Noda teaches a touch input screen overlaid on the display and coupled to the processor for receiving user input (**Col. 4, lines 41-55**).

As to **Claim 8**, Noda teaches the housing comprises a shock absorbing material (**Fig. 7, Element 29 and Col. 3, lines 11-16 and Col. 5, lines 10-23 and 60-67**).

As to **Claim 12**, Noda teaches the processor is further programmed with instructions for configuring the electronic tablet as a printer whereby content is receivable from a coupled computer in a print operation to the electronic tablet and displayed on the display (**It is inherent that when an electronic tablet receives information/data from an external computer that it will convert the information/data into a form that is appropriate for its display**).

As to **Claim 13**, Noda teaches the processor further programmed with instructions for configuring the electronic tablet as a storage device whereby content is receivable from a coupled computer and stored in a memory (**It is inherent that when an electronic tablet receives information/data from an external computer that it has the capacity to store the information/data in memory**).

### **Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noda.

As to **Claim 14**, Noda fails to teach the housing has dimensions of approximately 8.5 inches by 11 inches. However, the specification shows no apparent benefits from having a housing with the dimensions of 8.5 inches by 11 inches. Therefore, having a housing with the dimensions of 8.5 inches by 11 inches is clearly a design choice based on the specific requirements of the claim. Furthermore, it would have been obvious to a one of ordinary skill in the art to include a housing of any size, including having the dimensions of 8.5 inches by 11 inches, into the electronic tablet taught by Noda, since any dimension would perform equally well at protecting the electronic components. In addition it would have been obvious to a one of ordinary skill in the art to include a housing with the dimensions of 8.5 inches by 11 inches so that the device may be more portable.

12. Claims 5, 6, 9-11, 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noda in view of Acharya (USPGPUB 2004/0236647—herein referred to as “Acharya”).

As to **Claims 5 and 15**, most of the claim limitations have already been discussed with respect to the rejection of Claim 1 and 7, with the exception of a rechargeable battery within the housing and a USB port within the housing for receiving viewable content in a digital format from a connectable computer. Examiner cites Noda to teach a rechargeable battery within the housing (***Fig. 11, Element 23 and Col. 4, lines 65-66***). Although Noda teaches external ports (***Fig. 6, Elements 25 and 27***), he fails to teach a USB port within the housing. Examiner cites Acharya to teach an

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electronic tablet comprising a USB port within a housing (**Acharya—Fig. 5, Element 29 and Pg. 4, ¶ 0051 and Pg. 5, ¶ 0058**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a USB port as taught by Acharya in the electronic tablet taught by Noda in order to allow for electronic communication with other communication devices (**Acharya—Pg. 4, ¶ 0051**).

As to **Claim 6**, Noda fails to teach the data port comprising a flash ROM port for receiving a flash ROM card. Examiner cites Acharya to teach a flash ROM port for receiving a flash ROM card (**Acharya—Fig. 5, Elements 15 and 25 and Pg. 6 ¶ 0063**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a flash ROM port as taught by Acharya in the electronic tablet taught by Noda in order to allow another means for information to be passed from one electronic device to another electronic device (**Acharya—Pg. 4, ¶ 0051**).

As to **Claim 16**, Noda teaches a plurality of ports located proximate to each other and each sealed in a waterproof manner behind their individual access door (**Fig. 6, Elements 25 and 27 and Fig. 5, Elements 37 and 39**). However, Noda fails to teach the port being a flash ROM port, and the flash ROM port located proximate to the USB port such that, when the access door is in the closed position, the flash ROM port is sealed in a waterproof manner behind the access door. Examiner cites Acharya to teach a flash ROM port located proximate a USB port (**Acharya—Fig. 5, Elements 15, 25 and 29**). At the time the invention was made, it would have been obvious to a



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person of ordinary skill in the art to incorporate the use of a flash ROM port as taught by Acharya in the electronic tablet taught by Noda in order to allow another means for information to be passed from one electronic device to another electronic device (**Acharya—Pg. 4, ¶ 0051**). In addition, since the specification shows no apparent benefits for having a single access door cover all of the ports it is a clear design choice based on the specific requirements of the claim. Furthermore, it would have been obvious to one of ordinary skill in the art to include any waterproof access door, including a single integrated waterproof access door that would cover all the ports, into the electronic tablet taught by Noda as modified by Acharya since any waterproof access door would perform equally well at keeping water out of the ports. Finally, it would have been obvious to one of ordinary skill in the art to include a single integrated access door to cover all the ports in the electronic tablet taught by Noda as modified by Acharya so as to simplify the manufacturing process.

As to **Claim 17**, most of the claim limitations have already been discussed with respect to the rejection of Claim 16, with the exception of the electronic apparatus comprising a plurality of flash ROM ports. Noda, as modified by Acharya, fails to teach a plurality of flash ROM ports. However, the specification fails shows no apparent benefits from having a plurality of ROM ports. Therefore, having a plurality of flash ROM ports is clearly a design choice based on the specific requirement of the claim. Furthermore, it would have been obvious to one of ordinary skill in the art to include any number of flash ROM ports in the electronic tablet taught by Noda as modified by Acharya since any number of flash ROM ports would work equally well at allowing

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information to be passed from one electronic device to another electronic device

**(Acharya—Pg. 4, ¶ 0051).**

As to **Claims 9-11**, Noda fails to teach a wireless interface comprising an infrared/RF interface for receiving the viewable content in a digital format. Examiner cites Acharya to teach a wireless interface comprising an infrared/RF interface for receiving the viewable content in a digital format **(Acharya—Pg. 5, Last sentence of ¶ 0063 and Pg. 6, Last sentence of ¶ 0064)**. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a wireless interface as taught by Acharya in the electronic tablet taught by Noda in order to communicate with other electronic devices without the use of a cable thereby providing more freedom to relocate.

As to **Claim 19**, Noda fails to teach the housing has dimensions of approximately 8.5 inches by 11 inches. However, the specification shows no apparent benefits from having a housing with the dimensions of 8.5 inches by 11 inches. Therefore, having a housing with the dimensions of 8.5 inches by 11 inches is clearly a design choice based on the specific requirements of the claim. Furthermore, it would have been obvious to a one of ordinary skill in the art to include a housing of any size, including having the dimensions of 8.5 inches by 11 inches, into the modified electronic tablet taught by Noda and Acharya, since any dimension would perform equally well at protecting the electronic components. In addition it would have been obvious to a one of ordinary skill in the art to include a housing with the dimensions of 8.5 inches by 11 inches in the

modified electronic tablet taught by Noda and Acharya so that the device may be more portable.

13. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noda in view of Baraban et al. (U.S. Patent 7,065,658—herein referred to as “Baraban”).

As to **Claim 2**, Noda teaches a rechargeable battery within the housing (***Fig. 11, Element 23 and Col. 4, lines 65-66***). Noda, however, fails to teach an inductive charger within the housing for recharging the battery. Examiner cites Baraban to teach an inductive charger within the housing for recharging the battery (***Baraban—Fig. 6 and 7, Element 620 and Col. 5, line 63-Col. 6, line 16***). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate an inductive charger within a housing as taught by Baraban in the electronic tablet taught by Noda in order to make the device watertight and ruggedized (***Baraban—Col. 2, lines 36-39***).

As to **Claims 3 and 4**, Noda, as modified by Baraban, fails to teach the inductive charger comprises a high frequency coil that operates at a frequency of about 100 kHz. Examiner takes Official Notice that having a high frequency coil that operates at a frequency of about 100 kHz is well known in the art. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a high frequency coil with a frequency of about 100 kHz in the electronic tablet taught by Noda so that the device may charge up appropriately. Furthermore, at the time the invention was made, it would have been obvious to a person of ordinary

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skill in the art to incorporate the use of a high frequency coil at a frequency of about 100 kHz in the electronic tablet taught by Noda in order to reduce noise.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noda and Acharya as applied to claims 5, 6, 9-11 and 15-17 above, and further in view of Baraban.

As to **Claim 18**, Noda, as modified by Acharya, fails to teach an inductive charger within the housing for recharging the battery. Examiner cites Baraban to teach an inductive charger within the housing for recharging the battery (**Baraban—Fig. 6 and 7, Element 620 and Col. 5, line 63-Col. 6, line 16**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate an inductive charger within a housing as taught by Baraban in the modified electronic tablet taught by Noda and Acharya in order to make the device watertight and ruggedized (**Baraban—Col. 2, lines 36-39**).

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noda and Acharya as applied to claims 5, 6, 9-11 and 15-17 above, and further in view of Ohmori et al. (U.S. Patent 6,339,431—herein referred to as “Ohmori”)

As to **Claim 20**, Noda, as modified by Acharya, teaches a touch input screen able to receive user-generated input from the touch input screen (**Noda—Col. 4, lines 51-55 and Acharya—Pg. 2, ¶ 0012**). Noda, as modified by Acharya, however, fails to teach the processor further programmed with instructions for: storing the annotations

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with the displayed content whereby the annotations are displayed with the content.

Examiner cites Ohmori to teach receiving user-generated input from the touch input screen and representative of written annotations of displayed content; and storing the annotations with the displayed content whereby the annotations are displayed with the content (*Ohmori—Fig.1, Entire figure and Col. 5, lines 1-14 and Col. 10, lines 25-52*). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the electronic device store annotations with the displayed content and have them reappear on command as taught by Ohmori in the modified electronic tablet taught by Noda and Acharya so that a user may electronically edit a document and remember his annotations.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney Amadiz whose telephone number is (571) 272-7762. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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*R.A.*

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